

REMARKS

Claims 33 and 36-38 are pending in the present application and are rejected. Claims 33, 36 and 37 are herein amended. New claims 39-44 are added herein. No new matter has been added.

Applicant's Response to Claim Rejections under 35 U.S.C. §112

Claim 36 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

It is the position of the Office Action that claim 36 is improper because it does not recite a structural element. In response, Applicant herein amends claim 36 in order to clarify that separating spectroscopic information from noise is a functional feature of the “means” of claim 33. Additionally, Applicant herein amends the “means comprising a grating, or dichromatic mirror or Fourier spectrometer” as a “separating means” in claim 33. Further, Applicant herein adds new claim 39 to recite that the separating means comprises a grating, dichromatic mirror or Fourier spectrometer.

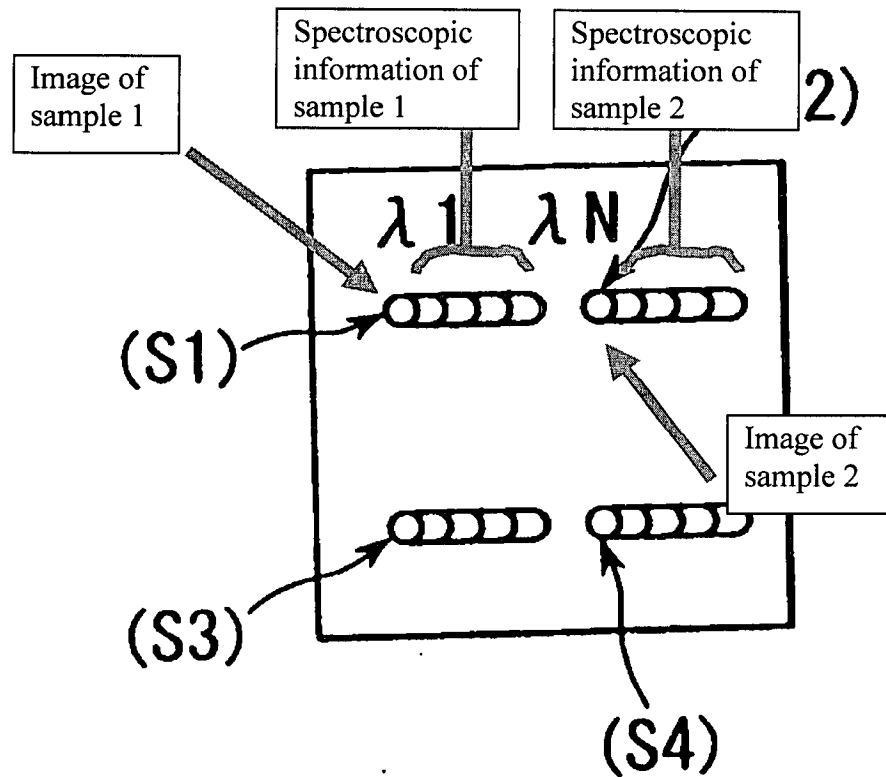
In addition, Applicant herein makes other various amendments in order to improve the clarity and form of the claims. Favorable reconsideration is respectfully requested.

Applicant's Response to Claim Rejections - 35 U.S.C. §102

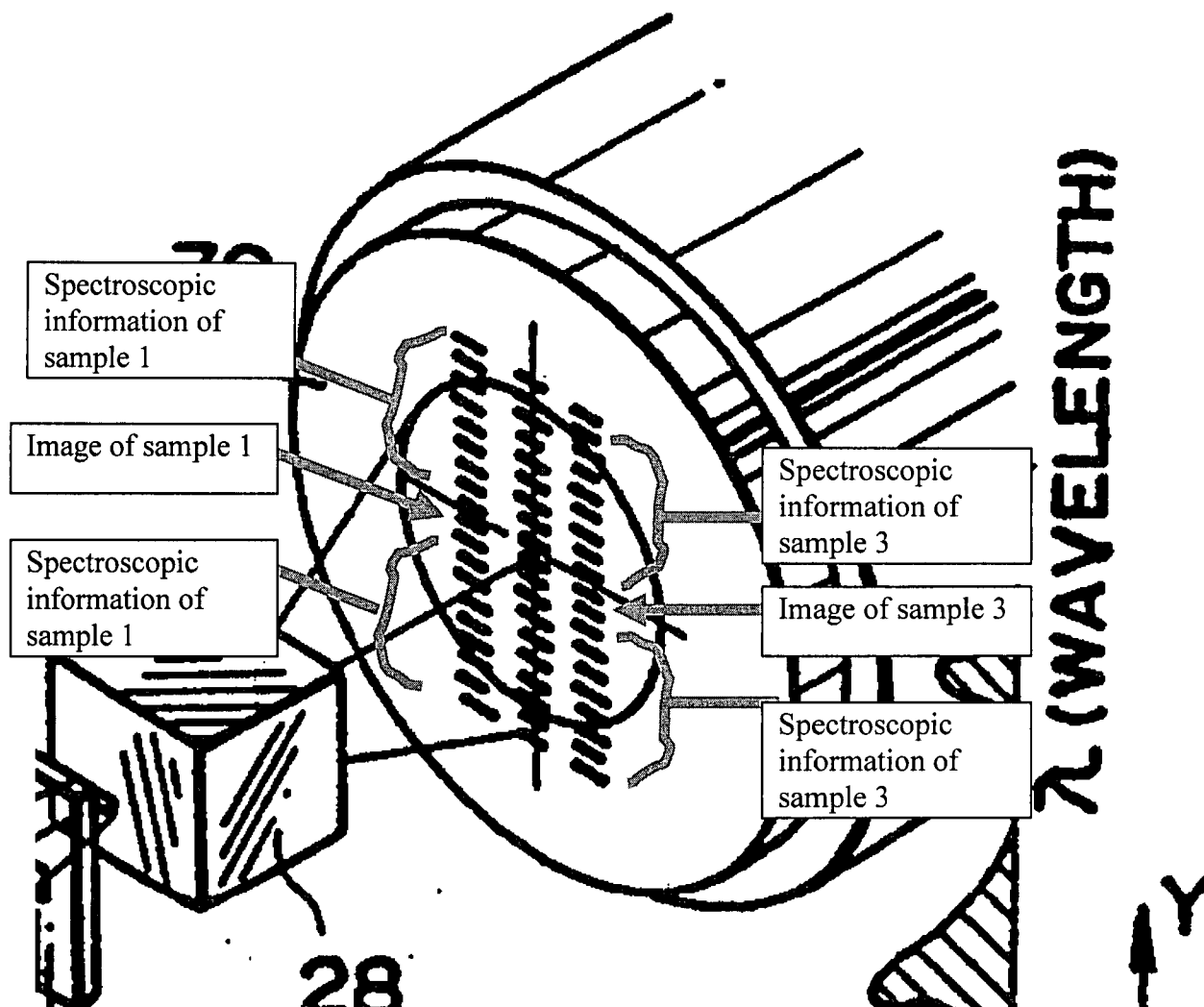
Claims 33 and 36-38 are rejected under 35 U.S.C. §102(b) as being anticipated by Ogino (U.S. Patent No. 5,422,712).

It is the position of the Office Action that Ogino discloses the embodiments as claimed. Ogino is directed at an apparatus for measuring fluorescent spectra of particles in a flow. In the embodiment of Figure 10, Ogino discloses a flow cell 16 including flat flow 64, which is irradiated by light source 10. The sample in the flow cell 16 emits fluorescent light, which passes through dichroic mirror 24 and slit 68. The fluorescent light passing through the slit 68 then passes through spectroscopic means 28, which converts the fluorescent light into a spectrum, which is projected on image intensifier 30. This is better illustrated in Figure 11. The image then passes through relay lens 32 and to two-dimensional image sensor.

In response to the previous remarks, on page 8 of the Office Action, it is stated that Figure 11 discloses display of multiple samples at the same time. In response, Applicant herein amends claim 33 to recite that the separating means develops the fluorescent light such that the spectroscopic information is “developed *between* images of said plurality of samples.” This is illustrated, for example, in Figure 8. Please see the marked-up Figure 8 on the following page.



However, the embodiments are Ogino are not capable of such a development of spectroscopic information. Rather, even if Ogino is broadly interpreted as developing spectroscopic information of multiple samples simultaneously, Ogino cannot develop spectroscopic information *between* images of the samples. Rather, in Ogino, the spectroscopic information is developed *above and below* the image of the sample. Please see the marked up Figure 11 of Ogino on the following page.



Applicant respectfully submits that the claimed embodiments distinguish over Ogino for at least this reason.

Additionally, Applicant respectfully submits that the embodiment of claim 37 distinguishes over Ogino. Applicant herein amends claim 37 to recite “a shield having a plurality of apertures aligned with positions of each of said plurality of samples,” as illustrated in Figure

15(B). Ogino does not disclose or suggest such a shield as claimed. Ogino requires a circular or rectangular slit. See column 5, lines 37-38. Ogino does not disclose or suggest a plurality of slits, but rather a single circular or rectangular slit. As such, Applicant respectfully submits that Ogino does not disclose or suggest the embodiment of claim 37. Favorable reconsideration is respectfully requested.

Finally, Applicant notes that Ogino is adapted for analysis of fluids such as blood or urine. On the other hand, the claimed embodiments are adapted for analysis of biochips having fixed spots. Although a biochip is recited in claim 33, the biochip is not “positively recited.” Rather, the biochip of claim 33 is “contextually” recited to help explain the features and functions of the claimed biochip reader. As such, Applicant herein adds new claims which recite “a combination” of the biochip reader and the biochip. Please see new claims 40-44. Favorable consideration is respectfully requested.

Claims 33 and 36-38 are rejected under 35 U.S.C. §102(e) as being anticipated by Kauvar (U.S. Patent No. 6,492,125).

It is the position of the Office Action that Kauvar discloses the embodiments as claimed. Kauvar is directed at a method to assess library x library interactions. In Figure 1, Kauvar generically discloses the system in which the method is applied, including an arc lamp, an objective lens, a polychroic mirror and a CCD array. However, Kauvar is mainly directed at varying the ratios of different color labels. Kauvar appears to mention the use of grating to

separately perceive multiple wavelengths. See column 2, lines 54-65. The Office Action focuses on this passage in the remarks on page 9.

In response, Applicant respectfully submits that Kauvar is at most duplicative of Ogino. Even if Kauvar is broadly interpreted as developing spectroscopic information of multiple samples simultaneously, Kauvar cannot develop spectroscopic information *between* images of the samples, as explained above with reference to marked up Figure 8.

Additionally, Applicant respectfully submits that the embodiment of claim 37 distinguishes over Kauvar. As noted above, Applicant herein amends claim 37 to recite “a shield having a plurality of apertures aligned with positions of each of said plurality of samples,” as illustrated in Figure 15(B). Kauvar does not disclose or suggest such a shield as claimed. As such, Applicant respectfully submits that Kauvar does not disclose or suggest the embodiment of claim 37. Favorable reconsideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

If the Examiner deems that any further action by applicant would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicant's undersigned attorney.

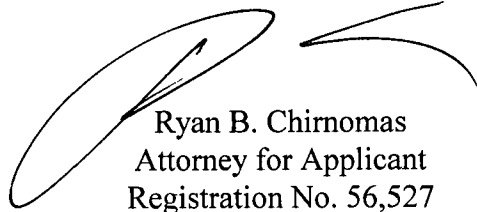
Application No. 10/769,017
Art Unit: 1797

Amendment
Attorney Docket No. 082726A

If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'Ryan B. Chirnomas', is written over the printed name and title.

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